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TO AMEMBASSY SEOUL

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TAGS: EIND, PFOR, KS

SUBJECT: RIGHT OF PRIORITY ON PATENT APPLICATIONS FILED IN KOREA

REFS: A) SEOUL 2340; B) SEOUL 4076; C) SEOUL 4111

SUMMARY: PRELIMINARY KOREAN DECISION TO DENY RIGHT OF PRIORITY TO US PATENT APPLICANTS CAUSES SERIOUS CONCERN TO US GOVERNMENT AND INDUSTRY. EMBASSY REQUESTED TO SEEK REVERSAL OF THIS DECISION ON BASIS OF INFORMATION CONTAINED HEREIN SO THAT US NATIONALS CAN CONTINUE TO RECEIVE RIGHT OF PRIORITY FOR PATENT APPLICATIONS FILED AFTER JANUARY 1, 1974. END SUMMARY.

1. INFORMATION CONTAINED IN REF A IS CAUSE OF SERIOUS CONCERN TO WASHINGTON AGENCIES AND MAY RESULT IN LOSS OF CERTAIN INDUSTRIAL PROPERTY RIGHTS OF U.S. NATIONALS APPLYING

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FOR PATENTS IN KOREA. AS WE UNDERSTAND THE SITUATION, THE KOREAN PATENT OFFICE WILL NOT RECOGNIZE A CLAIM TO A RIGHT OF PRIORITY BY FOREIGN PATENT APPLICANTS ON APPLICATIONS FILED IN KOREA AFTER JANUARY 1, 1974, DATE THE NEW KOREAN PATENT LAW TOOK EFFECT, UNLESS THERE IS A SPECIFIC BILATERAL AGREEMENT PROVIDING FOR SUCH RECOGNITION. REF A INDICATES THAT MINISTRY OF FOREIGN AFFAIRS OFFICIAL HAS GIVEN

Margaret P. Grafeld Declassified/Released US Department of State EO Systematic Review 22 May 2009

PRELIMINARY OPINION THAT BILATERAL TREATY OF FRIENDSHIP, COMMERCE AND NAVIGATION (FCN) DOES NOT PROVIDE SUFFICIENT BASIS FOR RECOGNIZING RIGHT OF PRIORITY.

2. FYI. THE RIGHT OF PRIORITY IN THE CASE OF PATENTS, TRADEMARKS, AND INDUSTRIAL DESIGNS IS ONE OF THE MOST IMPORTANT RIGHTS AS REGARDS THE PROTECTION OF INDUSTRIAL PROPERTY ABROAD. IT IS ONE OF THE KEY PROVISIONS IN THE MULTILATERAL PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY TO WHICH THE U.S. AND 86 OTHER COUNTRIES, BUT NOT KOREA, ADHERE. THIS RIGHT MEANS THAT, ON THE BASIS OF A REGULAR FIRST APPLICATION FILED IN ONE OF THE CONTRACTING STATES, THE APPLICANT MAY, WITHIN A CERTAIN PERIOD OF TIME (12 MONTHS FOR PATENTS), APPLY FOR PROTECTION IN THE OTHER CONTRACTING STATE; THIS LATER APPLICATION WILL THEN BE TREATED AS IF IT HAD BEEN FILED ON THE SAME DAY AS THE FIRST APPLICATION. IN OTHER WORDS, THIS LATER APPLICATION WILL HAVE PRIORITY (HENCE THE EXPRESSION "RIGHT OF PRIORITY") OVER APPLICATIONS WHICH MAY HAVE BEEN FILED DURING THE SAID PERIOD OF TIME BY OTHER PERSONS FOR THE SAME INVENTION. MOREOVER, THIS LATER APPLICATION, BEING BASED ON THE FIRST APPLICATION, WILL NOT BE INVALIDATED BY ANY ACTS ACCOMPLISHED IN THE INTERVAL, SUCH AS, FOR EXAMPLE, PUBLICATION OR EXPLOITATION OF THE INVENTION, AND THESE ACTS CANNOT GIVE RISE TO ANY RIGHTS FOR THE BENEFIT OF UNCLASSIFIED

THIRD PARTIES. A CLAIM BY A U.S. PATENT APPLICANT TO THE RIGHT OF PRIORITY IN A FOREIGN COUNTRY CAN BE BASED ON THAT COUNTRY'S ADHERENCE TO THE PARIS CONVENTION, TO THE INTER-AMERICAN REGIONAL TREATY, OR ON THE BASIS OF A BILATERAL AGREEMENT WHICH CONTAINS PROVISIONS TO THIS EFFECT. END FYI.

3. THE U.S. PATENT OFFICE HAS BEEN ACKNOWLEDGING A RIGHT OF PRIORITY TO KOREAN NATIONALS FILING PATENT APPLICATIONS IN THE U.S. FOR MANY YEARS, EVEN PRIOR TO THE ENTRY INTO FORCE OF THE FCN TREATY IN 1956. UNTIL ENACTMENT OF THE NEW PATENT LAW, THE ROK RECIPROCALLY RECOGNIZED U.S. NATIONALS' CLAIMS TO RIGHTS OF PRIORITY IN APPLICATIONS FILED IN KOREA.

4. IF ROK DECISION TO NO LONGER RECOGNIZE A RIGHT OR PRIORITY FOR U.S. NATIONALS FILING IN KOREA IS ACTUALLY IMPLEMENTED, SERIOUS INEQUITIES TO U.S. PATENT APPLICANTS IN KOREA COULD RESULT. APPLICATIONS AFTER JANUARY 1, 1974 WOULD NOT BENEFIT FROM RIGHT OF PRIORITY AND, LACKING THIS BENEFIT, SOME INVENTIONS MAY NO LONGER BE PATENTABLE IN KOREA BECAUSE OF INTERVENING ACTS. THIS WOULD BE UNFAIR TO

U.S. NATIONALS APPLYING FOR PATENTS IN KOREA WHO HAD LONG
BENEFITED FROM, AND THEREFORE HAD COME TO EXPECT, THIS

RIGHT. THE ROK MADE NO EFFORT TO COMMUNICATE THIS IMPORT-
ANT CHANGE TO THE U.S. AT THE TIME OF THE PASSAGE OF THE
NEW LAW, EVEN THOUGH THE LAW, UNDER THE PRELIMINARY KOREA
INTERPRETATION, WOULD HAVE A SERIOUS EFFECT ON PATENT
PROCEDURES.

5. ANOTHER CONSEQUENCE OF THE ROK DECISION WOULD BE THAT
KOREAN NATIONALS APPLYING FOR PATENTS IN THE U.S. WOULD
LOSE THEIR CLAIM TO A RIGHT OF PRIORITY ALSO. EXISTING
U.S. PATENT LAW (35 USC 119) REQUIRES THE U.S. PATENT
OFFICE TO RECOGNIZE PRIORITY CLAIMS BY APPLICANTS FROM
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OTHER COUNTRIES ONLY WHEN THE GOVERNMENTS OF SUCH COUNTRIES
PROVIDE A "SIMILAR PRIVILEGE" TO U.S. NATIONALS. IF SUCH
SIMILAR PRIVILEGE NO LONGER EXISTS, THEN THE U.S. PATENT
OFFICE CANNOT RECOGNIZE, UNDER 35 USC 119, CLAIMS FOR A
RIGHT OF PRIORITY BY KOREAN INVENTORS WHO HAVE FILED PATENT
APPLICATIONS IN THE U.S. PATENT AND TRADEMARK OFFICE SINCE
JANUARY 1, 1974.

6. IN VIEW OF THE FOREGOING, IT IS HIGHLY DESIRABLE THAT
THE PRELIMINARY DECISION BY THE KOREAN GOVERNMENT DESCRIBED
IN PARA 2, REF A BE RESERVED. BEST APPROACH CURRENTLY
AVAILABLE APPEARS TO LIE IN CONVINCING KOREAN AUTHORITIES
TO RECOGNIZE THAT 1956 FCN TREATY PROVIDES SUFFICIENT BASIS
FOR CONTINUED RECIPROCAL RECOGNITION OF RIGHT OF PRIORITY.
UNDER THIS PREFERRED INTERPRETATION, ROK WOULD TREAT PATENT
APPLICATIONS MADE AFTER JANUARY 1, 1974 SAME AS APPLICA-
TIONS BEFORE THAT DATE WITH REGARD TO RIGHT OF PRIORITY.

7. ACTION REQUESTED: EMBASSY REQUESTED TO CONTACT ROK
OFFICIALS BY DIPLOMATIC NOTE OR OTHER APPROPRIATE MEANS
AND, ON THE BASIS OF THE POINTS MADE IN PRECEDING PARA-
GRAPHS, SEEK KOREAN GOVERNMENT CONFIRMATION THAT RIGHT OF
PRIORITY FOR U.S. NATIONALS APPLYING FOR PATENTS IN KOREA
IS UNAFFECTED BY THE 1974 CHANGE IN PATENT LAW.

8. IF ROK IS NOT PERSUADED AND STANDS BY PRELIMINARY
DECISION DESCRIBED REF A, EMBASSY SHOULD ADOPT FALL-BACK
POSITION DESCRIBED HEREUNDER.

9. ARTICLE X, PARA 1 OF THE 1956 FCN TREATY PROVIDES THAT:
"NATIONALS AND COMPANIES OF EITHER PARTY SHOULD BE ACCORDED
WITHIN THE TERRITORIES OF THE OTHER PARTY, NATIONAL TREAT-
MENT AND MOST-FAVORED-NATION TREATMENT WITH RESPECT TO
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OBTAINING AND MAINTAINING PATENTS OF INVENTION, AND WITH RESPECT TO RIGHTS IN TRADEMARKS', TRADE NAMES, TRADE LABELS AND INDUSTRIAL PROPERTY OF EVERY KIND."

10. UNDER THE CONCEPT OF THE "MOST-FAVORED-NATION" CLAUSE, ANY FAVOR, PRIVILEGE OR THE LIKE GRANTED BY ONE OF THE CONTRACTING PARTIES TO A THIRD STATE IN RELATION TO A GIVEN SUBJECT SHALL BE EXTENDED TO NATIONALS OF THE OTHER CONTRACTING PARTY. AS WE UNDERSTAND IT, ROK NOW RECOGNIZES RIGHT OF PRIORITY FOR NATIONALS OF A THIRD COUNTRY, SPAIN, AS RESULT OF BILATERAL AGREEMENT WHICH CAME INTO EFFECT AUGUST 15, 1975 (REFS B AND C). THEREFORE, UNDER THE "MOST-FAVORED-NATION" PROVISION OF THE US/ROK FCN TREATY, KOREA IS OBLIGED TO RECOGNIZE U.S. PATENT APPLICANTS' RIGHT OF PRIORITY FOR ALL APPLICATIONS FILED IN KOREA AFTER AUGUST 15, 1975.

11. ACTION REQUESTED: IF ROK RESPONSE TO PREFERRED US POSITION IS NEGATIVE, EMBASSY REQUESTED TO MAKE POINTS RAISED IN PARAGRAPHS 9 AND 10 ABOVE AND TO SEEK CONFIRMATION THAT KOREAN PATENT OFFICE WILL RECOGNIZE RIGHT OF PRIORITY FOR US PATENT APPLICATIONS FILED WITH KOREAN OFFICE AFTER AUGUST 15, 1975. EMBASSY SHOULD ALSO POINT OUT THAT PROBLEM WOULD STILL REMAIN FOR APPLICATIONS FILED IN PERIOD JANUARY 1, 1974 TO AUGUST 15, 1975 AND ASK IF THE ROK HAS ANY SUGGESTIONS ON HOW TO AVOID THIS INEQUITY FOR US NATIONALS WHO FILED PATENT APPLICATIONS IN THAT TIME PERIOD. VANCE

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